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09/439,838 11/12/99 CROY

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EXAMINER

TM02/0410

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ART UNIT

PAPER NUMBER

2173

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/439,838

Applicant(s)
Clemens Croy et al.

Examiner
Tadesse Hailu

Group Art Unit
2173



☒ Responsive to communication(s) filed on Nov 12, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-50 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-36 and 38-50 is/are rejected.
- ☒ Claim(s) 37 is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4 and 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This Office Action is in response to the patent application (09/439, 838) filed 11/12/1999.

Priority

2. Acknowledgment is made of applicant's claim the benefit under Title 35, U.S.C. Section 120 of (cip of 09/078,604).

Information Disclosure Statement

3. The IDS submitted on 10/24/2000 and 12/14/2000 (paper #4 & #5) is considered by the examiner.

Status of the claims

4. Claims 1-50 are pending.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. **Claims 1-4, 6-11, 16-22, 31, 33-36, 38-44, 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Allport (6,097,441).**

Allport discloses the combination of the present claim elements including a **base station unit** (fig. 2, #75) having a CPU (155), "micro controller" and a plurality of data interface coupled

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to the CPU as shown in fig. 3; the base unit further including a video and audio signals (85) interface as shown in fig. 3. Allport also discloses a **remote control unit** (fig. 2, #10) in communication with the base unit (75) (see fig. 4) via RF antenna (280), "data link." The hand held device further including a display (15) for displaying and rendering information received from video interface (*claim 1*). The hand held remote control device further includes a video interface (300); a decoder (285) and a display component (380) (*claim 38*).

The base station unit (75) of Allport ('441) further includes the following: The integrated functionality of the base station unit and the remote control unit and/or TV set (Abstract, col 3, lines 48-62, col 9, lines 19-45), also integrated into a cable box ("set-top-box") (col 9, lines 36-65), integrated into a computer (fig.3) (col 15, lines 47-col 16, lines 5) (*claims 16, 17, 18 and 19* respectively). The base station unit (75) further includes a video tuner (125) (*claim 21*). A charging unit (225) (*claim 40*); an embedded browser (fig. 3, #85, col 12, lines 11-44) (*claims 46 and 47*).

The remote control unit (10) of Allport ('441) further includes the following: the remote control 10 is capable of receiving RF data 275 through an RF antenna 280 ("wireless telephone") (col 15, lines 12-20) (*claim 20*); including control information for remotely controlling an electronic appliance (col 11, lines 23-50) (*claim 36*); LCD display (380), a speaker (385), headphone (col 8, lines 5-26) (*claim 41*); a help button (col 6, lines 21-40) (*claim 42*); embedded browser (col 12, lines 11-44) (*claim 44*), an interface to a different user operating a second hand-held remote device (interface 280) (*claim 49*).

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The integrated control device (fig. 2) of Allport ('441) further includes the following: the data interface further includes a modem (145) (*claim 2*), a cable box ("set-top-box") interface (col 9, lines 36-65) (*claim 3*); interface for another computer such as via modem (145) or interface via RS232 (140) (*claim 4*); the interface further includes a VBI decoder (col 12, 11-44) (*claim 48*). The external information of the control device includes information obtained from the electronic commerce information (col 12, lines 11-44), Internet, including e-mail information (95) (*claims 6, 7 and 8 respectively*); control code information (col 9, lines 19-55) (*claim 9*); software or firmware upgrade for the base unit or the remote device (col 8, lines 33-col 9, lines 10) (*claim 10*). The data-link of the control device further includes an infrared link (215 or 135) (*claim 33*); RF link (185) (*claim 34*); direct electrical link (140) (*claim 35*). The control device further includes non-volatile memory device coupled to CPU (210 and 195) (*claim 11*). The control device further includes overlay unit for combining said video content with CPU generated images (fig. 3, col 13, lines 32-45) (*claim 22*). the display component renders the video content on an attached television set (fig. 2, col 9, lines 46-65) (*claim 39*).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. **Claims 5, 12-15, 23-30, 32, 45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allport (6,097,441) in view of Allport (6,104,334).**

While Allport ('441) does show a plurality of interface units (see fig. 4), the remote control unit (10) having a smart card interface is not shown. However, Allport's other patent ('334) shows this shortcomings. '334 does show a smart card for receiving additional external information and a software application (col 9, lines 6-20, col 21, lines 18-58) (*claims 12 and 15*) and for proper password or other "log-on" means ("validating user identity") (col 9, lines 6-20) (*claim 13*); and for enabling execution of applications (col 9, lines 6-20, col 21, lines 18-58) (*claim 14*).

In addition, while Allport ('441) does disclose a remote control device having a selection component for selecting a program, selecting a program by a different categories is not clearly shown. However, again, ('334) shows this shortcomings. ('334) includes a selection component for selecting a program by program time from a selection list (col 10, lines 18-38, col 12, lines 45-52) (*claims 23*); by program type (col 9, lines 6-43, fig. 3) (*claim 24*); by broadcast station from a selection list (fig. 7, col 12, lines 45-52) (*claims 25*); by program keyword (col 22, lines 33-col 23, lines 22) (*claims 26*); by personal preferences using a selection list (figs. 7 and 9, col 9, lines 44-57) (*claims 27*); by personal preferences using a code input (col 20, lines 55-col 21, lines 30) (*claims 28*); for activating a function for displaying detailed information about a particular program (col 12, lines 45-col 13, lines 6, fig. 4) (*claims 29*); for activating a marking function for making at least one program for application of further specified functions (col 15, lines 42-59, fig.

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6) (*claims 30*); automatically arranging menu selections of the selection list based on a history of user selections previously made (col 20, lines 21-40) (*claims 32*); an information display for displaying a history of user selections previously made (col 10, lines 18-26) (*claim 31*);

Furthermore, while ('441) does disclose a plurality of storage for a remote control unit and for a base station unit, the remote control unit and the base station unit having a personal database and user profile is not exclusively shown. However, ('334) discloses this shortcomings (col 7, lines 53-col 8, lines 12) (*claims 43, 45 and 50*).

At last, while ('441) does disclose the data interface for sending and/or receiving external information, the external information having electronic program guide information is not explicitly shown. However, ('334) does show this shortcomings (figs. 5 and 6) (*claim 5*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate the to use of smart card with other memory/data cards, and to incorporate several selection component program guide and personal database with selection component and memory storage of ('441). Thus, since both ('334 and '441) are directed to a manipulation, such as viewing, displaying and surfing an integrated device (base station and remote control), incorporating the two prior art yields an abundant information and wider scope of the intended discovery.

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Allowable Subject Matter

9. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for allowance:

The examiner has carefully considered the claims 1-50. The present invention relates to a remote control unit and remotely controlling functions of electronic devices having access to network delivered information and for displaying the same. All of the present invention claims are described and disclosed by Allport ('334 & '441) except for claim 37, wherein a display component for displaying a dual partition selection list, and a selection component for selecting elements from the dual partition selection list, and among others as recited in the claim are not disclosed by prior art of record.

Allport discloses a dual display system or multiple cooperating displays. The display area is surrounded by various physical actuating buttons (see fig. 1). While each selectable button independently displays its content, this selection and displaying of Allport is not in a ping-pong fashion, that is to say, "a selection made from the first selection list using the first selection component causing a display of corresponding items in the second list while the first selection list is at least partly concurrently displayed, a selection made from the second selection list using the second selection component causing a display of corresponding items in the first selection list while the second selection list is at least partly concurrently displayed."

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Thus, prior art of record fails to teach the combination of claim elements as recited in claim 37. Thus, prior art neither renders obvious nor anticipates the combination of claimed elements in light of the specification.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Tadesse Hailu*, whose telephone number is (703) 306-2799. The Examiner can normally be reached on M-F from 9:00 - 5:30 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, *John Cabeca*, can be reached at (703) 308-3116 Art Unit 2173 CPK 2-4A51

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu 2 April 2001


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173